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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,296	02/18/2004	Waheed M. Roomi	11957/66	4800

7590 10/04/2006  
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EXAMINER

SOLOLA, TAOFIQ A

ART UNIT PAPER NUMBER

1626

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/781,296

**Applicant(s)**

ROOMI ET AL.

**Examiner**

Taofiq A. Solola

**Art Unit**

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 16 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-9, 19-22 and 25-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 19, 20, 26, 27, 30, 34, 36, 37, 40, 41 and 43-45 is/are allowed.
- 6) ☐ Claim(s) 1-9, 21, 22, 25, 28, 29, 31-33, 35, 38-39, 42 and 46-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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Claims 1-9, 19-22, 25-50 are pending in this application.

Claims 10-18, 23-24 are cancelled.

### ***Request for Continued Examination***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.117(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/2/06 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 21-22, 25, 28-29, 31-33, 35, 38-39, 42 and 47-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "polylysine", line 2, claims 21-22, 25, 28-29, 31, 35, 38-39, 42 lacks proper antecedent basis in independent claim 19 or 26. Therefore, claims 21-22, 28-29, 31, 35, 38-39, 42 are indefinite. Claim 25 is indefinite for depending from a cancelled claim 23. By deleting the claims the rejection would be overcome.

Claims 32-33 are confusing and therefore, indefinite. It is confusing how e.g. proline and lysine-proline would bind at C-6 at the same time. By adding "then" between "and" and "a" the rejection would be overcome.

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Claims 47-50 improperly depend from claim 46 for failure to further limit the scope of claim 46. Claims 46-50 are drawn to composition but claims 47-50 recite intended use of the composition. However, intended use is not a limitation of a compound or product claim. *In re Hack*, 114USPQ 161 (CCPA, 1957); *In re Craig*, 90 USPQ 33 (CCPA, 1951); *In re Brenner*, 82 USPQ 49 (CCPA, 1949). Therefore, the claims are duplicates of claim 46. By deleting the claims the rejection would be overcome.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 46-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rath et al., EP 0 891 771 A1.

Applicant claims the composition of ascorbic acid wherein the ascorbic acid is covalently bound to lysine, or proline or both at C-2 and/or C-6 of the ascorbic acid.

#### **Determination of the scope and content of the prior art (MPEP §2141.01)**

Rath et al., teach the composition comprising ascorbic acid with lysine, proline or both. Rath et al., teach that the individual compounds may be covalently or ionically bound salts in the composition. See page 2, lines 45-57 and page 4, lines 48-50.

#### **Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)**

The difference between the instant invention and that of Rath et al., is that applicant claims the covalent bond is at position C-2 and/or C-6 of the ascorbic acid while Rath et al., do not specify the C-position.

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*Finding of prima facie obviousness--rational and motivation (MPEP §2142.2413)*

However, by applicant's admission, many substitutions of ascorbic acid are known, particularly, at positions C-2 and C-6. See the specification, page 3, lines 18-27.

Therefore, the instant invention is prima facie obvious from the teaching of Rath et al. One of ordinary skill in the art would have known to perform the covalent bond at position C-2 and/or C-6 at the time the invention was made. The motivation is from the teaching of Rath et al., that the individual compounds in the composition may be covalently bound.

Applicant's arguments filed 2/16/06 have been fully considered but they are not persuasive. Applicant contends that substitution at C2, C3, C5 and C6 are well known and that EP 0891771 fails to suggest selection of position C2 or C6. This is not persuasive for reasons set forth above. The Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is teaching, suggestion, or motivation to do so is found in the references themselves. However, it can also be established by knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the instant case one of ordinary skill in the art would have known a routine procedure to select 2 of 4 positions, and because selection of few among many is prima facie obvious. *In re Lemin*, 141 USPQ 814 (1964).

***Allowable Subject Matter***

Claims 19-20, 26-27, 30, 34, 36-37, 40-41, 43-45 are allowable over prior arts of record.

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***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.



**TAOFIQ SOLOLA**  
**PRIMARY EXAMINER**  
Group 1626

September 21, 2006